

REMARKS

Claims 33, 35, 37-39, and 41-46 are all the claims presently pending in the application. Claims 33, 35, 38, 41, 42, 45, and 46 are amended. Claims 1-32, 34, 36, and 40 are canceled.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Entry of this § 1.116 Amendment is proper. Since the Amendments above narrow the issues for appeal and since such features and their distinctions over the prior art of record were discussed earlier, such amendments do not raise a new issue requiring a further search and/or consideration by the Office. As such, entry of this Amendment is believed proper and Applicants earnestly solicit entry.

The contents of the present Office Action are addressed in the following discussion.

I. THE PRIOR ART REJECTIONS**A. The Alleged Kim and Taira Combination**

Claims 33, 35, 37-39, and 41-45 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kim et al. (U.S. Patent Publication No. 2003/0012558 A1) in view of Taira et al. (U.S. Patent No. 6,009,234).

Kim is directed to providing an information storage medium containing multi-language markup document information, and an apparatus for and a method of reproducing the information storage medium. (Kim at Abstract.) Taira is directed to providing a recording apparatus for recording information in the large-capacity recording medium. (Taira at column 1, lines 9-27.) The Office alleges that the combination of Kim and Taira makes the independent claim obvious.

However, Applicants respectfully disagree and submit that the Office fails to meet the initial burden of establishing obviousness. As a result, a *prima facie* case of obviousness is not established. Thus, since the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness, the burden to establish patentability is not shifted to Applicants.

Specifically, MPEP § 2142 provides

[t]he legal concept of *prima facie* obviousness is a procedural tool of examination It allocates who has the burden of going forward with production of evidence The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness

(emphasis added).

The Office admits that Kim fails to teach or suggest an information storage medium for use with a reproducing apparatus providing a visual display of interactive graphics, “*wherein . . . one interactive graphics stream among the plurality of interactive graphics streams is selected by an interactive graphics stream number stored in a player status register in the reproducing apparatus*”, as recited, for example, in claim 33. (Office Action at page 4, third full paragraph.)

To make up for this admitted deficiency, the Office applies Taira. The Office alleges, at page 4, third paragraph of the present Office Action, that

Taira teaches a method of reproducing information in which a language code is stored in the player apparatus and is used to select a data stream (see Taira column 43 lines 51-56, “*the language previously held in the apparatus, or the player, is referred to and an audio stream and a video stream are set*”).

However, the Office takes the above-referenced portion of Taira out of context. Specifically, “the language previously held in the apparatus” refers back to column 42, lines 22-38 of Taira. This portion of Taira states,

[a]ccordingly, the VTS menu as shown in FIG. 84 is displayed, for example. In this example, “Mr. X's Life” appears as a title and “1. Infancy”, “2. Youth”, “3. Middle Age”, and “4. Old Age” appear as parts of the title that can be chosen. Once the user has chosen a part of the title from the menu by pressing the corresponding key on the key/display section 4, for example, the language selection menu, a submenu, appears. Specifically, since 32 sub-picture streams have been prepared as sub-pictures as explained earlier, the movie suppliers can display one of, for example, English, Japanese, German, and French sub-pictures. Furthermore, a menu that allows selection of one from eight audio streams can be prepared as another submenu. This makes it possible to choose any one of audio streams associated with dubbing. Selecting a choice from the menu causes the program chain corresponding to the choice to be reproduced.

(emphasis added.)

Therefore, while the portion of Taira cited by the Office supports the Office’s argument when taken out of context, it teaches away from the Office’s argument when interpreted in context

with column 42, lines 22-38. Simply, Taira teaches that a language is selected by a user in response to a menu provided by a DVD. Taira fails to teach or suggest that one interactive graphics stream among the plurality of interactive graphics streams is selected by an interactive graphics stream number stored in a player status register in the reproducing apparatus.

For all of the above-referenced reasons, the Office fails to meet the initial burden of establishing obviousness. As a result, a *prima facie* case of obviousness is not established. Thus, since the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness, the burden to establish patentability is not shifted to Applicants.

Therefore, Applicants respectfully request the Office to reconsider and withdraw this rejection.

B. The Lamkin Reference

Claim 46 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kim in view of Taira, and further in view of Lamkin et al. (U.S. Patent Publication No. 2002/0078144 A1).

To make up for admitted deficiencies of the alleged Kim and Taira combination not discussed above, the Office applies Lamkin. Lamkin is directed to providing a media services interface for use in a readable medium playback device. (Lamkin at Abstract.) The Office alleges that the combination of Kim, Taira, and Lamkin makes the independent claim obvious.

However, the Office fails to produce evidence and factually support that Lamkin makes up for any of the above-referenced deficiencies with respect to the alleged Kim and Taira combination. Thus, even in spite of the attempt to modify the alleged Kim and Taira combination through the application of Lamkin, the Office fails to meet the initial burden of establishing obviousness. As a result, a *prima facie* case of obviousness is not established. Thus, since the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness, the burden to establish patentability is not shifted to Applicants.

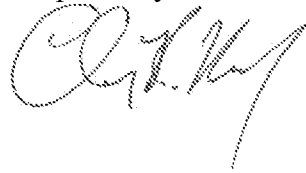
Therefore, Applicants respectfully request the Office to reconsider and withdraw this rejection.

II. CONCLUSION

In view of the foregoing, Applicants submit that claims 33, 35, 37-39, and 41-46, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Office is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Office find the application to be other than in condition for allowance, the Office is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Respectfully Submitted,



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